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09/656,765	09/07/2000	Jeremy S DeBonet	11291.00007/GST	1556
30636 7590 04/30/2008 FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038				
EXAMINER				
TODD, GREGORY G				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/656,765

Applicant(s)

DEBONET ET AL.

Examiner

GREGORY G. TODD

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to applicant's amendment filed 11 February 2008, of application filed, with the above serial number, on 07 September 2000 in which claims 1, 23, and 29 have been amended. Claims 1-37 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to include that, in substance: the broadcast element selector automatically selects non-advertisement broadcast elements without any selection by the user of the non-advertisement broadcast elements that are provided to the user. Said amendment is new matter. Applicant cites specification p. 15 line 1 - p. 16 line 6 as support for such amendment. However, cited section, at most, details that the audio element selection functions select audio elements, such elements may include advertisements. In fact, the specification explicitly only cites that advertisements are automatically selected and that

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all elements *including advertisements* are automatically selected, however, this is not the same as non-advertisements only being automatically selected. The only portion on the specification to differentiate element types from advertisements, p. 19 line 9-12, refers to the differentiation among element *types*, not the elements themselves. Correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-12, 14-34, and 36-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolfe et al (hereinafter "Wolfe", 6,161,142).

As per Claims 1 and 29, Wolfe discloses a personal broadcast/audio server system for providing a customized broadcast to one or more users over a transmission media, wherein Wolfe discloses:

a data storage device for storing a plurality of broadcast elements, each broadcast element having at least one broadcast type, wherein the broadcast elements include broadcast elements of at least two types (various databases, ie. databases 30

or 18-21, music and advertisements being two types) (at least Fig. 1; col. 3 line 66 - col. 4 line 29);

a data management system for storing a user profile and a user state for each of said one or more users, wherein said data management system further stores information associated with each of said plurality of broadcast elements (subscriber profile database 28) (at least Fig. 1; col. 3 line 66 - col. 4 line 29; col. 4, lines 43-60);

a broadcast element selector having at least one broadcast element selection function for each broadcast type, wherein each broadcast element selection function is operable to select automatically broadcast elements from said data storage device based on a user's user profile, the user's user state, and the information associated with each of said plurality of broadcast elements (specific material vary as a function of subscriber dossier) (at least col. 3, lines 39-49; col. 6, lines 30-56; col. 4, lines 27-29, 54-63; col. 7, lines 46-67; subscriber selecting content and an associated advertising message selected accordingly), wherein the broadcast element selector automatically selects non-advertisement broadcast elements without any selection by the user of the non-advertisement broadcast elements that are provided to the user (at least col. 6:28-56; eg. non-advertisement wrapper message being appended); and

a broadcast server operable to receive the selected broadcast elements from said data storage device and to provide the selected broadcast elements to the user over the transmission media (transmitting over internet) (at least Fig. 1; col. 6, lines 30-42).

As per Claims 2 and 30.

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wherein said data storage device is a file server (at least Fig. 1; col. 3 line 66 - col. 4 line 3; col. 3, lines 30-33).

As per Claims 3 and 31.

wherein said data management system is a database (at least Fig. 1; col. 4, lines 16-21).

As per Claims 4 and 32.

wherein the system resides on a single computing device (at least Fig. 1; col. 3 line 66 - col. 4 line 3).

As per Claims 5 and 33.

wherein the system resides on multiple computing devices (at least Fig. 1; col. 3 line 66 - col. 4 line 3).

As per Claim 6.

wherein said data management system further includes a history of usage for each of said one or more users, and wherein said broadcast element selector is further operable, to exclude broadcast elements from being delivered to a user based on the user's history of usage (purchasing habits, previous music selections, etc) (at least col. 4 line 64 - col. 5 line 8).

As per Claim 7.

wherein said broadcast element selector retrieves the user profile and user state directly from said data management system (at least Fig. 1; col. 6, lines 35-56; col. 5, lines 9-14).

As per Claim 8.

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wherein said broadcast server retrieves the user profile and user state from said data management system and provides said user profile and user state to said broadcast element selector (at least col. 5, lines 9-14; col. 6, lines 35-56; Fig. 1).

As per Claim 9.

wherein said broadcast elements include audio (at least col. 3, lines 39-44).

As per Claim 10.

wherein said broadcast elements include video (at least col. 3, lines 39-44; col. 5, lines 20-30).

As per Claim 11.

wherein said transmission media is the Internet (at least col. 3, lines 36-40).

As per Claim 12.

wherein said transmission media is a local area network (at least col. 3, lines 36-44).

As per Claim 14.

wherein the user profiles stored is in the data management system include initial registration information derived from when the user first logs in (at least Fig. 2; col. 3, lines 32-36; col. 5 line 64 - col. 6 line 8).

As per Claim 15.

wherein the user profiles stored is in the data management system include information related to a user's preferred frequency of content (at least col. 6, lines 57-63; col. 5, lines 3-8).

As per Claim 16.

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wherein the user profiles stored in the data management system include demographic information relating to each user (at least col. 4 line 64 - col. 5 line 8; col. 4, lines 16-21).

As per Claim 17.

wherein the user profiles stored in the data management system are automatically updated based on the user's pattern of usage (at least col. 4 line 64 - col. 5 line 8).

As per Claim 18.

wherein said broadcast element selector selects broadcast elements based on a collaborative filtering process (best fitting music selection) (at least col. 4 line 64 - col. 5 line 8).

As per Claim 19.

wherein the system is implemented in software on a single computer (at least col. 3 line 65 - col. 4 line 10; col. 3, lines 30-35).

As per Claim 20.

wherein the system is implemented as multiple software programs executing on more than one server (at least col. 3 line 65 - col. 4 line 10; col. 3, lines 30-35).

As per Claim 21.

wherein the servers are located in more than one physical location (at least col. 4, lines 3-10; Fig. 1; col. 7, lines 10-19).

As per Claim 22.

wherein said each broadcast element selection function is operable to select broadcast elements based on a user request (subscriber making music selections) (at least col. 5, lines 57-67; col. 6, lines 25-29).

As per Claim 23, Wolfe discloses a personal radio server system for providing a customized radio broadcast to one or more users, a system, wherein Wolfe discloses:

a general purpose computer having a central processing unit and memory for storing user profiles for one or more users and an audio element cache for storing a plurality of audio elements that corresponds to a user profile (at least Fig. 1; col. 3 line 66 - col. 4 line 29);

said central processing unit implementing a program that causes the central processing unit to produce individual audio streams for each of the one or more users based on the user profiles stored in memory (specific material vary as a function of subscriber dossier) (at least col. 3, lines 39-49; col. 6, lines 30-56; col. 4, lines 27-29, 54-63; col. 3, lines 6-8), wherein every non-advertisement broadcast element in the audio streams is automatically selected without any selection by the user of the non-advertisement broadcast element's that are provided to the user (at least col. 6:28-56; eg. non-advertisement wrapper message being appended).

As per Claim 24.

wherein the individual audio is streams comprise one or more audio elements (at least col. 3, lines 2-8).

As per Claim 25.

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wherein the audio elements are stored as a library of digital elements (at least col. 4, lines 16-29).

As per Claim 26.

further comprising a file server for storing the library of digital elements (at least Fig. 1; col. 3 line 66 - col. 4 line 3; col. 3, lines 30-33; col. 4, lines 16-29).

As per Claim 27.

further comprising an audio element selector for selecting audio elements for each of the one or more users (at least col. 6, lines 35-56).

As per Claim 28.

wherein the audio element selector is implemented as separate threads for each of the one or more users (at least col. 6, lines 17-24; Fig. 3).

As per Claim 34.

wherein said audio elements include advertising (at least col. 6, lines 35-56).

As per Claim 36.

wherein said audio element server comprises a radio program clock for selecting the type of audio element to transmit based on frequency parameters specified in a particular user's profile (purchasing habits, previous music selections, etc) (at least col. 4 line 64 - col. 5 line 8; col. 3, lines 44-51).

As per Claim 37.

wherein the frequency parameters are selected by the user (purchasing habits, previous music selections, etc) (at least col. 4 line 64 - col. 5 line 8).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Mackintosh et al (hereinafter "Mackintosh", 6,317,784).

As per Claim 13.

Wolfe fails to explicitly disclose the transmission media is a wireless communications network. However, the use and advantages for using such a network is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Mackintosh (at least col. 21, lines 47-55; col. 8, lines 51-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Mackintosh's wireless network into Wolfe's system as this would enhance Wolfe's system to be operable on more networks as wireless is simply a common variant for a network to operate on in particular networks and offers portable broadcast music just as FM radio broadcasts is very popular.

As per Claim 35.

Wolfe fails to explicitly disclose the audio elements include talk by a DJ. However, the use and advantages for using such an audio element is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Mackintosh (at least col. 3, lines 1-16). Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to incorporate the use of DJ tracks being incorporated into Wolfe's system as Wolfe discloses broadcasting radio broadcasts over the internet (at least col. 10, lines 30-56) and DJ commentary is simply another form of audio content to be streamed as commonly done in the radio industry.

Response to Arguments

7. Applicant's arguments filed 11 February 2008 have been fully considered but they are not persuasive.

Applicant argues Wolfe does not teach wherein the broadcast element selector automatically selects non-advertisement broadcast elements without any selection by the user of the non-advertisement broadcast elements that are provided to the user. Wolfe teaches a system to "automatically make music selections and the like" (col. 5:57-67) via free programs, such automatic language indicating, contrary to Applicant's interpretation, the subscriber is *not*, in fact, manually selecting pieces of music, but rather the program is automatically selecting music for the subscriber. However, for the sake of argument, assuming Wolfe teaches a system where, a user would, arguably, request music selections; in response, the system would provide the selection, as well as advertisements, and in addition to advertiser's messages types being appended with the selections, other various non-advertisement messages/pieces are also appended, among other things, to include generic or music specific voice overs or statements from artists, ie. wrappers (at least col. 6:28-56). Such non-advertisements are automatically selected without user intervention to the response.

It is further noted, that at least Claim 22, offers that the broadcast selection function 'select[s] broadcast elements based on a user request'. As such, the claim element contradicts the 'automatic' nature provided in claim 1.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Previously cited Chen et al (par. 41-43; profile subsystem automatically controlling selector for may element types), Root et al (col. 6:5-18; automatic custom weather service delivery), Bates et al (automatic audio broadcast selection), Cliff (automatic compilation of songs), Rosenberg et al, Srinivasan et al,

Lotspiech et al, and Rouchon are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY G. TODD whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. G. T./
Examiner, Art Unit 2157

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/Ario Etienne/

Supervisory Patent Examiner, Art Unit 2157